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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Opposition No. 91159389

VITACILINA CORPORATION OF  
AMERICA

v.

ROSA WEST LABORATORIES, INC.

Before Walters, Holtzman and Zervas, Administrative  
Trademark Judges.

By the Board.

Rosa West Laboratories, Inc. ("applicant") has filed an application to register the mark VITASILK-C for "non-medicated skin care products in the nature of multivitamin facial treatments, namely, facial scrubs and masks."<sup>1</sup>

Registration has been opposed by Vitacilina Corporation of America ("opposer") on the grounds of likelihood of confusion, deceptiveness, deceptive misdescriptiveness and dilution. Opposer has also pleaded that it successfully opposed an earlier-filed application for the mark VITASILK by applicant in a prior opposition proceeding.

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<sup>1</sup> Application Serial No. 76513143, filed April 21, 2003, claiming an intent to use the mark in commerce.

Applicant, in its answer, essentially denies the salient allegations of the notice of opposition. Applicant, however, has admitted many of opposer's allegations regarding the filing of a previous application for the mark VITASILK and the ensuing opposition.

This case now comes up on (i) opposer's motion (filed February 1, 2005) in which opposer contends that applicant is barred from seeking to register the mark involved herein due to the judgment in the prior opposition under the doctrine of claim preclusion; and (ii) applicant's cross motion (filed February 17, 2005 via certificate of mailing) for partial summary judgment on opposer's claim of likelihood of confusion.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). All doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving

party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

We first turn to opposer's summary judgment motion. The parties do not dispute the following facts: On May 4, 2000, applicant filed application Serial No. 76040993 for the mark VITASILK for "non-medicated skin care products, namely, serums featuring fruit enzymes, gels, creams, toners, and cleansers; facial treatments, namely, masks and scrubs; and body treatments, namely, masks and scrubs." On March 19, 2002, opposer commenced an opposition against application Serial No. 76040993, which was assigned Opposition No. 91151186. About one year later, on February 10, 2003, the Board granted opposer's summary judgment motion as conceded under Trademark Rule 2.127(a), and entered judgment and refused registration of the involved application. On April 21, 2003, about two months after the Board entered judgment in the prior opposition, applicant filed the application which is the subject of the present proceeding.

Opposer maintains in its motion that applicant is barred by claim preclusion from registering the mark which is the subject of the present application. According to opposer, "the marks are for identical goods and differ only slightly - the second mark adds a letter 'C' to the end of the mark"; and "relatively minor alterations to a mark do

**Opposition No. 91159389**

not result in a ... new mark sufficient to allow an applicant to seek a new registration." Opposer's motion is supported by a copy of the Board's February 10, 2003 order in Opposition No. 91151186.

Applicant, in turn, argues that "no issues were actually litigated or decided in the first opposition proceeding" because applicant, "without the benefit of counsel, did not realize that when it has [sic] received the notice of opposition by the Opposer, it was necessary to respond to the Opposition and therefore, inadvertently lost the opposition by default."<sup>2</sup> Applicant also maintains that "there is truly no *res judicata*" because "applicant's marks in the prior proceeding and the current proceeding are notably different with different commercial impression[s], such that they cannot be considered to be the same claim"; and that "[t]he evidence relating to the issue of likelihood of confusion with the first mark is not precisely the same as the evidence with respect to the likelihood of confusion with the second mark."

Initially, we note that there is no question that opposer has standing to bring this action. Opposer has filed a status and title copy of its asserted U.S.

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<sup>2</sup> In its first application, applicant granted a power of attorney to Frank Gilliam and John Duncan. The record does not reflect that applicant revoked the power of attorney.

registration for the mark VITACILINA<sup>3</sup> with the notice of opposition, and one or more of its claims is not without merit. See *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Further, applicant has not challenged opposer's standing.

Turning next to the merits of opposer's motion, under the doctrine of res judicata or claim preclusion, the entry of a final judgment on the merits of a claim in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of default. *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990). Thus, a second suit is barred by res judicata or claim preclusion if (1) the parties (or their privies) are identical; (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first claim. *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000). We discuss each of the three *Jet, Inc.* elements below, as applied to this case.

(a) *Identity of Parties.*

Opposer maintains that "the first opposition proceeding [was] between Vitacilina and Rosa West Labs." Opposer is

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<sup>3</sup> Registration No. 1063707, registered April 19, 1977; renewed June 1, 1997.

incorrect. The first opposition was between opposer and Rosa West Inc. Rosa West Laboratories, Inc. is the applicant in the present proceeding. Thus, the parties are not identical in the two proceedings.

Applicant has not pointed out in its response that the defendants in the two proceedings differ, and has not argued that they are *not* in privity, and neither party has submitted any corporate information regarding applicant including, e.g., whether applicant has changed its name. However, applicant has characterized the marks of the two proceedings as "Applicant's marks." See p. 4 of applicant's response and cross motion. In view thereof, and in view of the fact that the two corporate names only differ by the addition of the term "Laboratories," we find that the opposers in the two proceedings are identical and that the applicants are either identical or in privity.

Thus, the first element of *Jet, Inc.* is satisfied.

*(b) Earlier Final Judgment on the Merits.*

Applicant maintains that in the prior proceeding, the applicant "inadvertently lost the opposition by default"; and that "no issues were actually litigated or decided in the first opposition proceeding [and that t]herefore, there really is no *res judicata*." Applicant is incorrect. The Board entered judgment on opposer's likelihood of confusion claim because the applicant had conceded opposer's

contentions in opposer's motion for summary judgment under Trademark Rule 2.127(a). Also, it is not necessary for issues to have been actually litigated in order for claim preclusion to apply.<sup>4</sup> See Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings*, 80 TMR 540 (1990) ("An involuntary dismissal generally operates as an adjudication upon the merits and will preclude a subsequent action based on the same cause of action.") In view thereof, we find that there was an earlier final judgment on the merits. The second element of *Jet, Inc.* is therefore satisfied.

(c) *The Second Claim is Based on Same Set of Transactional Facts.*

In evaluating the similarity of the claims, the Board "has looked to whether the mark involved in the first proceeding is the same mark, in terms of commercial impression, as the mark in the second proceeding." *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998). The Board has also considered whether the second mark differs from the first mark only in minor, insignificant ways. See *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999).

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<sup>4</sup> The doctrine applies even in those cases where the prior judgment was the result of a default or consent. See *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.2d 1325, 55 USPQ2d 1492 (Fed. Cir. 2000).

We find that there is no genuine issue of material fact that the two marks are virtually identical to one another and that the commercial impression of the marks is the same. The marks differ ever so slightly - the second mark merely adds a "-C" to the first mark. This difference is minor and insignificant, and certainly does not create a new mark. In fact, the specimen of use in the prior application showed the mark in use as "VITASILK - C."

With respect to the goods set forth in each application, the identification of goods in the first application is broad and encompasses the narrower identification in the second application. That is, the "non-medicated skin care products in the nature of multivitamin facial treatments, namely, facial scrubs and masks" of the second application are well within the "body treatments, namely, masks and scrubs" of the first application. The restriction in the present application that the goods are "non-medicated" and "multivitamin" does not aid applicant because, to the extent the identifications list the same items, the identification in the earlier application was unrestricted and has to be read to encompass the identified masks and scrubs (as body treatments) of all types. See, e.g., *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359 (TTAB 1988). Moreover, an applicant cannot avoid the estoppel effect of the decision



of a prior disposition by insignificantly changing its identification of goods. *Id.*

Thus, we find that the marks (and goods) are part of the same transaction, and the third *Jet, Inc.* element is also satisfied.

*Conclusion*

In view of the foregoing, we find that there are no genuine issues of fact, and that, as a matter of law, the instant opposition is barred by res judicata or claim preclusion and, therefore, opposer is entitled to summary judgment on this basis. Opposer, in obtaining a judgment in the prior proceeding, had a reasonable belief that any right applicant may have had to seek registration of its mark had been abandoned. Applicant is bound by that abandonment and is barred thereby from seeking to register a substantially identical mark for identical goods. See *Wells Cargo, Inc. (Elkart, Indiana) v. Wells Cargo, Inc., (Reno, Nevada)*, 606 F.2d 961, 203 USPQ 564 (CCPA 1979). Opposer's motion for summary judgment is therefore granted.

In view of our disposition of opposer's summary judgment motion, applicant's cross motion for partial summary judgment on opposer's claim of likelihood of confusion is moot. Moreover, applicant has not provided any evidence regarding the factors regarding likelihood of confusion of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

**Opposition No. 91159389**

1357, 177 USPQ 563 (CCPA 1973). Applicant's cross motion is therefore denied.

DECISION: Judgment is entered against applicant, the opposition is sustained and registration to applicant is refused.